

REMARKS/ARGUMENTS

Claims 1-47 remain in this application. Claims 13, 31, and 36 have been amended.

1. § 112 Rejections

Based on the amendments above, applicants request reconsideration and withdrawal of the rejection of claims 13 and 31 under 35 U.S.C. § 112, second paragraph.

2. § 102 Rejections

Applicants respectfully traverse the rejection of claims 1-9, 14-22, 27-35, 38-42, and 45-47 under 35 U.S.C. § 102 (b) as being anticipated by Chien et al (WO00/66636).

According to the Examiner, it is noted that Chien et al does not expressly teach "selecting a composition such that the Chang viscoelastic window when cured exhibits the coordinates found in claims 1, 18, and 31. However, Chein et al teaches the compositions as defined by the claims and exemplified by applicants' examples, therefore, it is deemed that the optical fiber coating compositions and coated fiber taught by Chein et al inherently will comprise some, if not all, the coordinates as disclosed by claims 1, 18, and 31."

Applicants respectfully disagree. Anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently in a single prior art reference. There is no mention or even any suggestion in the Chien et al reference of selecting the various constituents of the fiber coatings so that the coating will exhibit adhesive characteristics such that the composition will exhibit a Chang viscoelastic window within the parameters defined by claims 1, 18, or 31.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex Parte Levy, 17 USPQ2d 1461 (BPAI 1990). The Examiner has not

provided any basis in fact or technical reasoning to support why the allegedly inherent characteristic necessarily will flow from the teachings of the applied prior art.

Applicants' invention utilizes primary coatings which have pressure sensitive adhesive characteristics. Such an adhesive characteristic is actually unusual for a radiation curable optical fiber coating, which normally cure to a hard, non-tacky state.

Applicants respectfully traverse the rejection of claims 1-8, 10-21, 23-30, 38-39, and 41-42, as being anticipated under 35 U.S.C. § 102 (b) by Dillman et al (US 5,536,772) as evidenced by Chien.

According to the Examiner, "Dillman et al is deemed to anticipate the instant invention because Dillman et al teaches optical fiber coating compositions comprising a thermoplastic resin, such as styrene-diene block co-polymers and terpolymers, reactive diluents, tackifying resin, and a photoinitiator. Therefore, the examiner deems said coating compositions will inherently will comprise some, if not all, the coordinates as disclosed by claims 1 and 18."

Applicants respectfully disagree. Anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently in a single prior art reference. There is no mention or even any suggestion in the Dillman et al reference of selecting the various constituents of the fiber coatings so that the coating will exhibit adhesive characteristics such that the composition will exhibit a Chang viscoelastic window within the parameters defined by claims 1, 18, or 31.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex Parte Levy, 17 USPQ2d 1461 (BPAI 1990). The Examiner has not provided any basis in fact or technical reasoning to support why the allegedly inherent characteristic necessarily will flow from the teachings of the applied prior art.

Applicants respectfully traverse the rejection of claims 1-5, 8-9, 12, 18, 21-22, 25, 38-39, and 43-44 under 35 U.S.C. § 102 (b) as being anticipated by Lapin et al (US 5,891,930).

According to the Examiner, "Lapin et al is deemed to anticipate the instant invention because Lapin et al teach an optical fiber coating composition comprising a reactive monomer, a photoinitiator, a thermoplastic elastomer, and is devoid of

tackifying resins.” “Lapin et al teach compositions that anticipate the instant invention said compositions should inherently comprise some, if not all, the coordinates as disclosed by claims 1-5, 18, 38-39, and additionally not exhibit the coordinates set forth in claims 46-47.”

Applicants respectfully disagree. Anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently in a single prior art reference. There is no mention or even any suggestion in the Lapin et al reference of selecting the various constituents of the fiber coatings so that the coating will exhibit adhesive characteristics such that the composition will exhibit a Chang viscoelastic window within the parameters defined by claims 1, 18, or 31.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex Parte Levy, 17 USPQ2d 1461 (BPAI 1990). The Examiner has not provided any basis in fact or technical reasoning to support why the allegedly inherent characteristic necessarily will flow from the teachings of the applied prior art.

Because all of the claims depend, either directly or indirectly from independent claims 1, 18, and 31, it is submitted that these dependent claims are in allowable condition as well.

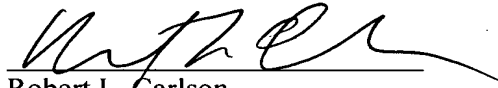
Based upon the above amendments, remarks, and papers of records, applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Applicant submits that the additional art made of record but not relied upon is no more pertinent than the art relied upon in the Examiner's rejections. Applicant believes that no extension of time is necessary to make this Reply timely. Should applicant be in error, applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Appl. No.: 10/087,481
Amdt. Dated: 01/05/2004
Reply to Office Action of: 10/03/2003

Please direct any questions or comments to Robert L. Carlson at 607-974-3502.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert L. Carlson', written over a horizontal line.

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